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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,357	09/10/2001	Janet A. Warrington	3355.1	9510

22886 7590 03/15/2005

AFFYMETRIX, INC  
ATTN: CHIEF IP COUNSEL, LEGAL DEPT.  
3380 CENTRAL EXPRESSWAY  
SANTA CLARA, CA 95051

EXAMINER

ZEMAN, MARY K

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 03/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/955,357

Applicant(s)

WARRINGTON, JANET A.

Examiner

Mary K. Zeman

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 13-21, 26-33 and 37-45 is/are rejected.
- 7) ☒ Claim(s) 10-12, 22-24, 34-36 and 46-48 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 1631, Examiner **Mary K Zeman**.

Claims 1-48 are pending in this application. The previously applied species election is withdrawn.

Applicant's arguments with respect to claims 1-48 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Duplicative claims***

Applicant is advised that should claims 13-24 be found allowable, claims 25-37 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Both sets of claims are drawn to a computer readable media comprising software code operative to perform the same tasks. As such, they appear duplicative.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9, 13-21, 25-33 and 37-45 are rejected under 35 U.S.C. 102(e) as being anticipated by CHEE (6,368,799)

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The applied reference has a common ASSIGNEE with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

CHEE discloses methods of correlating expression levels of gene profiles with genotypes, and haplotypes. At columns 8-9, Chee discloses how polymorphisms are identified in populations or differing individuals, then the gene expression profiles are correlated with those genotypes. Up to 100,000 differing probes can be assessed (col 10). Chee discloses that these correlations can be performed by programmed computers, or systems. These systems comprise computer readable media, and software for carrying out the methods. As such, Chee anticipates the claimed invention. It is noted there are no inventors in common with the instant application.

Claims 1-5, 13-17, 24-29 and 37-41 are rejected under 35 U.S.C. 102(e) as being anticipated by FAN et al. (USP 6,525,185)

The applied reference has a common ASSIGNEE with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

FAN et al. Disclose methods of identifying polymorphisms in groups of individuals, and identifying genes that segregate with those types of individuals. At column 10, the two (or more) groups of individuals can be differing in a phenotype, disease, or genotype. Polymorphic alleles are analyzed to determine if they segregate with a trait, disease, or genotype. A polymorphism can be an SNP, and multiple SNP's comprise a haplotype. This patent sets forth at least 500 differing sequences which can be utilized. This patent also discloses computer systems, computer readable media and software for carrying out the method. As such, Fan anticipates the claimed invention. It is noted there are no inventors in common with the instant application.

Claims 1-5, 13-17, 24-29 and 37-41 are rejected under 35 U.S.C. 102(e) as being anticipated by FAN et al. (US 2003/0170699 A1)

The applied reference has a common ASSIGNEE with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

FAN et al. Disclose methods of identifying polymorphisms in groups of individuals, and identifying genes that segregate with those types of individuals. At pages 4-8 the two (or more) groups of individuals can be differing in a phenotype, disease, or genotype. Polymorphic alleles are analyzed to determine if they segregate with a trait, disease, or genotype. A polymorphism can be an SNP, and multiple SNP's comprise a haplotype. This patent sets forth at least 500 differing sequences which can be utilized. This patent also discloses computer systems, computer readable media and software for carrying out the method. As such, Fan anticipates the claimed invention. It is noted there are no inventors in common with the instant application.

### ***Conclusion***

Claims 1-9, 13-21, 25-33 and 37-45 are rejected.

Claims 10-12, 22-24, 34-36 and 46-48 are objected to as being dependent from a rejected claim. These claims appear to be free of the prior art.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following are all assigned to Affymetrix and are related to genotyping, gene expression profiles and/or correlations thereof.

Zhou 2003/0198983 A1

Liu 2005/0009069 A1

Chiles 2004/0138821 A1.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary K Zeman whose telephone number is (571) 272 0723

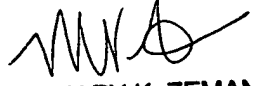
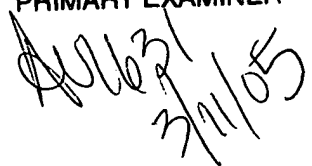
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, PhD can be reached on (571) 272 0718. The fax phone number for the organization where this application or proceeding is assigned is 571 273 8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

  
MARY K. ZEMAN  
PRIMARY EXAMINER  
  
2/11/05